

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-37. Claims 1-31 have been rejected. Independent claims 1, 11, and 21 have been amended to clarify aspects of the inventions. New claims 32-37 have been added.

Claims 1-7, 10-17, 20-27, and 30-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPP 2002/0104099 ("Novak") in view of USP 6628303 ("Foreman"). Claims 8-9, 18-19, and 28-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Novak in view of Foreman and USP 7,284,032 ("Weber"). The Applicant respectfully traverses these rejections for at least the following reasons.

#### **REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of

ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**I. The Proposed Combination of Novak and Foreman Does Not Render Claims 1-7, 10-17, 20-27, and 30-31 Unpatentable**

The Applicant first turns to the rejection of claims 1-7, 10-17, 20-27, and 30-31 under 35 U.S.C. 103(a) as being unpatentable over Novak in view of Foreman.

**A. Rejection of Independent Claim 1 under 35 U.S.C. § 103(a)**

With regard to the rejection of independent claim 1 under 35 U.S.C. § 102(e), the Applicant submits that Novak does not disclose or suggest at least the limitation of “editing, at said first geographic location, previously created metadata associated with said media content, said editing based on said additional media content,” as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

In reference to Claim 1, Novak teaches a method for producing and delivering media content (as shown in Figs. 4 and 11; with further reference to the descriptions of Paragraphs [0056-0060; 0077-0086]), the method comprising:

establishing a personal television channel at a first geographic location ("Joe's TV Channel" as shown in Figs. 6-9 created by the method of Figs. 4 and 11; With further reference to the operations of Upload Source 122, as described in Paragraphs [0039,0040,0041,0046,0055,0056,0068,0070,0074, and 0080])

*modifying existing media content to produce a media program (Fields 706 of Fig. 7 allow an individual to enter media object information or preferences, such as identifiers for date, time slot, media object identifier (ID), media object description, or file type, as described in Paragraph [0063-0067]. Once the individual has entered the media object information or preferences, the media objects are then compiled into the media program of Display 710, as described in Paragraph [0067]);*

*editing, at said first location, metadata associated with said media content (Fields 706 are customized by the individual, as described in Paragraphs [0063-0067]. In addition, the interface of Fig. 6 allows the uploading individual to create and edit a program schedule for Synthetic Channel);*

associating the produced media program and said edited metadata with the established personal television channel (EPG 802 of Fig. 8 and EPG 152 of Fig. 9, which show "Joe's TV Channel" in association with the broadcast times and Conventional Television Broadcast Channels of EPG 802, as described in Paragraphs [0071,0072])

communicating said produced media program along with said edited metadata to another geographic location ("Joe's TV Channel" is then communicated to the end user of STB 152 according the schedule times established by Upload Source 122, as described in Paragraphs [0059,0072]. In addition, the metadata edited by Upload Source such as program titles, scheduled broadcast times, and object IDs are communicated with the program content to the end user, as shown in Figs. 8 and 9, which correspond to the data of Fig. 7).

See the Final Office Action at pages 4-5 (emphasis added). In the above argument, the Examiner has equated Applicant's modifying of the existing media content to Novak's completion of fields 706 (entering media object information or preferences). The Applicant respectfully disagrees and points out that entering of the media object information and preferences does not include any modification to the related media content. In other words, there really isn't any modifying of existing media content by

Novak's user interface 702. Novak's content, as created by the upload source, stays the same and related information and preferences are added only for purposes of organizing the synthetic channel.

Furthermore, the Examiner has equated Applicant's editing of metadata with Novak's customization of fields 706, as described in paragraphs 0064-0067 and Fig. 7 of the reference. More specifically, the Examiner alleges that the information described by headings 704 (e.g., date, time slot, file type, media object description, etc) is equivalent to Applicant's metadata. Even if we assume, arguendo, that the headings 704 are metadata for the corresponding media files, the Final Office Action is still deficient. More specifically, **the information described by headings 704 is not "previously created metadata."** Fig. 7 of Novak illustrates the user interface that can be used to create the synthetic channel. Obviously, the information described by headings 704 is being currently created by the user interface in the process of setting up the synthetic channel, and it is not previously existing (or previously created). At most, Novak, in Fig. 7, discloses creation of metadata, not modification/editing of previously created metadata.

Furthermore, even if we assume, arguendo, that Fig. 7 illustrates editing of "previously created metadata", the Final Office Action is still deficient. More specifically, **Novak, including Fig. 7, does not disclose that such editing of metadata is based on the additional media content used to modify the existing media content.**

Therefore, the Applicant maintains that Novak does not disclose or suggest at least the limitation of "editing, at said first geographic location, previously created

metadata associated with said media content, said editing based on said additional media content,” as recited by the Applicant in independent claim 1. Foreman does not overcome the above deficiencies of Novak.

Accordingly, the proposed combination of Novak and Foreman does not render independent claim 1 unpatentable, and a prima facie case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-7, 10, 12-17, 20, 22-27, and 30-31**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) has been overcome and request that the rejection be withdrawn. Additionally, claims 2-7, 10, 12-17, 20, 22-27, and 30-31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-7, 10, 12-17, 20, 22-27, and 30-31.

## **II. The Rejection of Claims 8-9, 18-19, and 28-29**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) has been overcome and request that the rejection be withdrawn. Additionally, since the additional cited reference (Weber) does not overcome the deficiencies of Novak, claims 8-9, 18-19, and 28-29 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 8-9, 18-19, and 28-29.

## CONCLUSION

In general, the Final Office Action makes various statements regarding claims 1-31 and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. The Applicant expressly reserves the right, however, to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a future rejection).

The Applicant respectfully requests reconsideration of the objections and rejections for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney. The Applicant respectfully submits that claims 1-37 are allowable.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: June 2, 2009

MCANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
Telephone: (312) 775-8000  
Facsimile: (312) 775-8100

/Ognyan I. Beremski/  
Ognyan I. Beremski  
Registration No. 51,458  
Attorney for Applicant

/OIB